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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,718	11/28/2000	Larry Gold	NEX 10-6	1084

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EXAMINER

ZITOMER, STEPHANIE W

ART UNIT PAPER NUMBER

1634

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,718

Applicant(s)

GOLD ET AL.

Examiner

Stephanie Zitomer

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Application status

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 21, 2003 has been entered.
2. Rejections not reiterated herein from the previous Office action, mailed June 10, 2002, have been withdrawn in view of the submitted Terminal Disclaimers and new grounds for rejection. Applicant's arguments have been considered in full but are deemed moot in view of withdrawal of the previous rejections.

Double patenting obviousness type rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 5,705,337. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim recites nucleic acid ligands comprising chemically reactive functional units that are photoreactive groups that bind covalently with a target molecule wherein the recitation in the patent claim of a method of making the nucleic acid ligands comprising photoreactive groups does not

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define any structural differences that would distinguish the patent claim ligands from those of the application claim. Alternatively, following *Vogel*, the embodiment that provides support for the patent claim, Example 3 (columns 22-24), describes nucleic acid ligands to the HIV-1 Rev protein target that contain the photoreactive uracil analog, 5-iodouracil, as recited in application claim 12, which acts as a functional unit and which had been used in the prior art to generate crosslinks between nucleic acids and proteins (column 29, lines 49-54). In *Vogel*, the Court determined that "an embodiment disclosed in the patent which provides support for the patent claim" may be considered in determining whether or not the application claimed invention is an obvious variation of the patent claimed invention.

4. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 5,998,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim is drawn to a nucleic acid ligand which binds covalently with a protein wherein the nucleic acid ligand comprises a chemically reactive functional unit. The chemically reactive functional unit is defined at column 10, lines 23-27 as a photoreactive group. Alternatively, following *Vogel*, the embodiment that provides support for the patent claim, Example 4 (columns 29-30), describes nucleic acid ligands to the HIV-1 Rev protein target that contain the photoreactive uracil analog, 5-iodouracil, which acts as a functional unit and which had been used in the prior art to generate crosslinks between nucleic acids and proteins (column 29, lines 49-54). In *Vogel*, the Court determined that "an embodiment disclosed in the patent which provides support for the patent claim" may be considered in determining whether or not the application claimed invention is an obvious variation of the patent claimed invention.

5. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 5,962,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

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patent claim recites nucleic acid ligands having chemically reactive functional units that bind covalently with a target wherein the chemically reactive functional units are photoreactive groups and wherein the recitation in the patent claim of a method of making the nucleic acid ligands from a candidate mixture comprising nucleic acids having at least one chemically reactive functional unit which bind covalently with a target does not define any structural differences that would distinguish the patent claim ligands from those of the application claim. Alternatively, following *Vogel*, the embodiment that provides support for the patent claim, Example 3 (columns 25-26), describes nucleic acid ligands to the HIV-1 Rev protein target that contain the photoreactive uracil analog, 5-iodouracil, as recited in application claim 12, which acts as a functional unit and which had been used in the prior art to generate crosslinks between nucleic acids and proteins (column 29, lines 49-54). In *Vogel*, the Court determined that "an embodiment disclosed in the patent which provides support for the patent claim" may be considered in determining whether or not the application claimed invention is an obvious variation of the patent claimed invention.

Conclusion

6. **No claim is allowed.** However, the claims are free of the prior art and may be allowable with submission of a properly executed Terminal Disclaimer.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Zitomer whose telephone number is (703) 308-3985. The examiner can normally be reached on Monday through Friday from 9:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The official fax phone number for this Group is (703) 308-4242. The unofficial fax number is (703) 308-8724. The examiner's Rightfax number is 703-746-3148.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196. For questions and requests relating to formal matters contact LIE Chantae Dessau at 703-605-1237.

S. Zitomer
Stephanie Zitomer, Ph.D.
April 4, 2003

STEPHANIE W. ZITOMER
PRIMARY EXAMINER